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In re Application of
Mechoulam et al.
Application No.: 10/597,166
PCT No.: PCT/IL2005/000053
Int. Filing Date: 14 January 2005
Priority Date: 15 January 2004
Attorney Docket No.: LUZ033PU
For: Therapeutic Use Of Quinonoid
Derivatives Of Cannabinoids

DECISION

This is in response to the "Response To Notice To File Missing Requirements..." filed on 31 August 2008.

BACKGROUND

This international application was filed on 14 January 2005, claimed an earliest priority date of 15 January 2004, and designated the U.S. The International Bureau transmitted a copy of the published international application to the USPTO on 28 July 2005. The 30 month time period for paying the basic national fee in the United States expired at midnight on 15 July 2006. Applicant filed *inter alia* the basic national fee on 13 July 2006.

On 21 July 2008, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicant, requiring the filing of \$745.00 in additional claims fees, an oath or declaration compliant with 37 CFR 1.497(a) and (b) and certain requirements pertaining to a sequence listing

DISCUSSION

Applicant argues that the requirement for additional claims fees was improper in view of applicants' submission of a "new claim set intended to be examined... [which] consists of 41 total claims and no multiple dependent claims." Citing MPEP 714.01(e) and 506, and alluding to 37 CFR 1.53(b), petitioner further argues that no preliminary amendment was required for entry of the 41-claim set into the application. However, petitioner is respectfully advised that the relevant policy pertaining to national stage applications is explained at MPEP 1893.01(d):

A preliminary amendment accompanying the initial national stage submission under 35 U.S.C. 371 that *>is effective to cancel< claims and/or *>eliminate< multiple dependent claims will be effective to reduce the number of claims to be considered in calculating extra claim fees required under 37 CFR 1.492(d)-(e) and/or eliminate the multiple dependent claim fee required under 37 CFR 1.492(f). A subsequently filed amendment canceling claims and/or eliminating multiple dependent claims will not entitle applicant to a refund of fees previously paid. See MPEP § 607 and § 608.

Since the submission of 13 July 2006 did not include such a preliminary amendment, petitioner's argument concerning the requirement for additional claims fees is not persuasive.

Regarding the declaration, petitioner argues that it is not defective because applicants "used the form PTO/SB/01A promulgated by the Office when an Application Data Sheet is used," and that an ADS was in fact filed. However, inspection of the declaration reveals that one sheet appears to have been faxed while the other does not. This suggests that the sheets were not signed as a single document naming the entire inventive entity, but instead were assembled after signature to arrive at the declaration which was submitted. MPEP 201.03 explains in part that

While each inventor need not execute the same oath or declaration, each oath or declaration executed by an inventor must contain a complete listing of all inventors so as to clearly indicate what each inventor believes to be the appropriate inventive entity. Where individual declarations are executed, they must be submitted as individual declarations rather than combined into one declaration. For example, where the inventive entity is A and B, a declaration may not be executed only by A naming only A as the inventor and a different declaration may not be executed only by B naming only B as the inventor, which two declarations are then combined into one declaration with a first page of boiler plate, a second page with A's signature, and a second page with B's signature (so that it appears that the declaration was executed with the entire inventive entity appearing in the declaration when it did not).

Following this policy, it would not be appropriate to accept the declaration as filed on 11 April 2007.

Regarding the sequence listing-related requirements, petitioner urges "that the subject application does not qualify under the Sequence Rules as requiring a sequence listing." In view of the totality of the record, it would be appropriate to accept petitioner's statement that no sequence listing is required. Therefore, the sequence listing-related requirements are hereby **WITHDRAWN**.

DECISION

The petition is **DISMISSED**, without prejudice, to the extent noted above.

Applicants are required to file the response required by the 21 July 2008 Notification of Missing Requirements (except for the sequence listing-related requirements, as discussed above) within either (1) the remaining period for response to said Notification of Missing Requirements mailed on 21 July 2008, as extended under 37 CFR 1.136(a), or (2) **ONE (1) MONTH** from the mailing date of this Decision (**NOT** extendable), whichever expires later. Failure to timely reply will result in **ABANDONMENT**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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